



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/733,900	12/12/2000	Carlos O. Pinzon	05725.0595-00	5474

22852 7590 03/26/2002

FINNEGAN, HENDERSON, FARABOW, GARRETT &
DUNNER LLP
1300 I STREET, NW
WASHINGTON, DC 20005

EXAMINER

DEWITTY, ROBERT M

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 03/26/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/733,900

Applicant(s)

PINZON ET AL.

Examiner

Robert M DeWitty

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-346 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☐ Claim(s) ____ is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☒ Claim(s) 1-346 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) ____ | 6) <input type="checkbox"/> Other: |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1, 21-39, 40-49, 56-59, 66-84, and 186-189, drawn to a composition, classified in class 585, subclass 17.
 - II. Claims 1-17, 339-340, drawn to a composition, classified in class 585, subclass 316.
 - III. Claims 1, and 50-55, drawn to a composition, classified in class 585, subclass 6.6.
 - IV. Claims 1, and 60-63, drawn to a composition, classified in class 585, subclass 301.
 - V. Claims 1 and 64-65, drawn to a composition, classified in class 106, subclass 31.38.
 - VI. Claims 1 and 85-87, drawn to a composition, classified in class 424, subclass 1.25.
 - VII. Claims 1 and 88-94, drawn to composition, classified in class 424, subclass 476.
 - VIII. Claims 1 and 95-99, drawn to composition, classified in class 514, subclass 23.
 - IX. Claims 1 and 100-104, drawn to a composition, classified in class 424, subclass 549.

Art Unit: 1616

- X. Claims 1 and 105-107, drawn to a composition, classified in class 252, subclass 62.53. ✓
- XI. Claims 108-168, 171-183, and 341-342, drawn to a composition, classified in class 424, subclass 70.17.
- XII. Claims 108, and 169-170, drawn to a composition, classified in class 424, subclass 782. ✓
- XIII. Claims 108, and 190-192, drawn to a composition, classified in class 424, subclass 1.25.
- XIV. Claims 108, and 193-199, drawn to a composition, classified in class 424, subclass 476. ✓
- XV. Claims 108, and 200-204, drawn to a composition, classified in class 514, subclass 23. ✓
- XVI. Claims 108, and 205-209, drawn to a composition, classified in class 424, subclass 549. ✓
- XVII. Claims 108 and 210-212, drawn to a composition, classified in class 252, subclass 62.53. ✓
- XVIII. Claims 213-255, 259-261, 268-271, 278-296, 343-344, drawn to a composition, classified in class 540, subclass 320.
- XIX. Claims 213 and 262-267, drawn to a composition, classified in class 554, subclass 1. ✓
- XX. Claims 213 and 272-275, drawn to a composition, classified in class 252, subclass 69. ✓

Art Unit: 1616

- XXI. Claims 213 and 276-277, drawn to a composition, classified in class 424, subclass 9.322. ✓
- XXII. Claims 213 and 297-299 and 323-324, drawn to a composition, classified in class 424, subclass 1.25.
- XXIII. Claims 213 and 300-306, drawn to a composition, classified in class 424, subclass 476. ✓
- XXIV. Claims 213 and 307-311, drawn to a composition, classified in class 514, subclass 23. ✓
- XXV. Claims 213 and 312-316, drawn to a composition, classified in class 424, subclass 549. ✓
- XXVI. Claims 213 and 317-319, drawn to a composition, classified in class 252, subclass 62.53. ✓
- XXVII. Claim 320, drawn to a composition, classified in class 585, subclass 3.
- XXVIII. Claims 321-322, drawn to a composition, classified in class 424, subclass 401.
- XXIX. Claim 325 and 338, drawn to a make-up composition, classified in class 132, subclass 204.
- XXX. Claim 326, drawn to a lipstick, classified in class 401, subclass 49.
- XXXI. Claim 327-328
- XXXII. Claims 329-333 and 336, drawn to a composition, classified in class 540, subclass 320.

XXXIII. Claim 334, drawn to a method of application, classified in class 132, subclass 218.

XXXIV. Claims 335 and 337, drawn to a method of making a cosmetic, classified in class 252, subclass 62.53.

XXXV. Claims 345-346, drawn to a composition, classified in class 585, subclass 22.

The inventions are distinct, each from the other because:

2. Inventions I and XI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions the inventions are not disclosed as capable of use together, and they have different modes of operation, Invention I containing hydrocarbons, and Invention XI containing amides.

Inventions I and XVIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and they have different effects, Invention XVIII being drawn to anhydrous compositions.

Inventions XI and XVIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together

Art Unit: 1616

and they have different effects, Invention XVIII being drawn to anhydrous compositions containing hydrocarbons.

Inventions I and II, III, IV, V, VI, VII, VIII, IX, X are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as being capable of use together, and they have different effects, Invention I being drawn to a hydrocarbon containing nitrogen, sulphur, or phosphorous.

Inventions II and III, IV, V, VI, VII, VIII, IX, X are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions the inventions are not disclosed as capable of use together, and they have different effects, Invention II being drawn to alkynyl and alkenyl chains.

Inventions III and IV, V, VI, VII, VIII, IX, X are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and they have different effects, Invention III being drawn to a composition containing oil.

Inventions IV and V, VI, VII, VIII, IX, X are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have

Art Unit: 1616

different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and they have different effects, Invention IV being drawn to a composition containing volatile solvents.

Inventions V and VI, VII, VIII, IX, X are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and they have different effects, Invention V being drawn to a composition containing gum.

Inventions VI and VII, VIII, IX, X are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and they have different modes of operation, Invention VI being drawn to a composition in a particular form.

Inventions VII and VIII, IX, X are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together, and they have different effects, Invention VII being drawn to a composition containing a fatty alcohol.

Inventions VIII and IX, X are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together, and they have different effects, Invention VIII being drawn to a composition containing oil-soluble polymer.

Inventions IX and X are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together, and they have different effects, Invention IX being drawn to a composition containing an oil-soluble ester.

Inventions XI and XII, XIII, XIV, XV, XVI, XVII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions the inventions are not disclosed as capable of use together, and they have different effects, Invention XI being drawn to compositions containing alkynyl and alkenyl chains.

Inventions XII and XIII, XIV, XV, XVI, XVII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP §

Art Unit: 1616

806.04, MPEP § 808.01). In the instant case the different inventions the inventions are not disclosed as capable of use together, and they have different effects, Invention XII being drawn to compositions containing fatty material.

Inventions XIII and XIV, XV, XVI, XVII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together and they have different modes of operation, Invention XIII being drawn to a composition in a particular form.

Inventions XIV and XV, XVI, XVII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions the inventions are not disclosed as capable of use together, and they have different effects, Invention XIV being drawn to compositions containing fatty alcohol.

Inventions XV and XVI, XVII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together, and they have different effects, Invention XV being drawn to a composition containing oil-soluble polymer.

Art Unit: 1616

Inventions XVI and XVII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together, and they have different effects, Invention XVI being drawn to a composition containing wax.

Inventions XVIII and XIX, XX, XXI, XXII, XXIII, XXIV, XXV, XXVI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions the inventions are not disclosed as capable of use together, and they have different effects, Invention XVIII being drawn to compositions containing alkynyl and alkenyl chains.

Inventions XIX and XX, XXI, XXII, XXIII, XXIV, XXV, XXVI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together, and they have different effects, Invention XIX being drawn to a composition containing oil.

Inventions XX and XXI, XXII, XXIII, XXIV, XXV, XXVI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together

Art Unit: 1616

and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together, and they have different effects, Invention XX being drawn to a composition containing volatile solvent.

Inventions XXI and XXIII, XXIV, XXV, XXVI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together, and they have different effects, Invention XXI being drawn to a composition containing fatty material.

Inventions XXII and XXIII, XXIV, XXV, XXVI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together, and they have different effects, Invention XXII being drawn to a composition in a particular form.

Inventions XXIII and XXIV, XXV, XXVI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together, and they have different effects, Invention XXIII being drawn to a composition containing fatty alcohol.

Art Unit: 1616

Inventions XXIV and XXV, XXVI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together, and they have different effects, Invention XXIV being drawn to a composition containing oil-soluble polymer.

Inventions XXV and XXVI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together, and they have different effects, Invention XXV being drawn to a composition containing oil-soluble ester.

Inventions I, XI, XVIII, XXVIII, XXIX, XXX, XXXI, XXXII, XXXIII, XXXIV, XXXV and XXVII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together, and Invention XXVII has different effects, being drawn to a composition containing a hetero atom that is not nitrogen.

Inventions I, XI, XVIII, XXX, XXXI, XXXII, XXXIII, XXXIV, XXXV and XXVIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as

Art Unit: 1616

capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together, and they have different functions, Invention XXVIII being drawn to mascara, eyeliner, foundation, lipstick, blusher, removing product, make-up, eyeshadow, face powder, cocealer, nail composition, shampoo, conditioner, anti-sun product, product for skin, lips, hair.

Inventions I, XI, XVIII, XXX, XXXI, XXXII, XXXIII, XXXIV, XXXV and XXIX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together, and Invention XXIX has different effects, being drawn to a make-up for keratinous fibers.

Inventions I, XI, XVIII, XXXI, XXXII, XXXIII, XXXIV, XXXV and XXX are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together, and Invention XXX has different effects, being drawn to a lipstick

Inventions I, XI, XVIII, XXXII, XXXIII, XXXIV, XXXV and XXXI are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions

Art Unit: 1616

are not disclosed as capable of use together, and Invention XXXI has different effects, being drawn to a composition containing urea urethanes.

Inventions I, XI, XVIII, XXXIII, XXXIV, XXXV and XXXII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together, and Invention XXXII has different effects, being drawn to a make-up composition.

Inventions I, XI, XVIII, XXXIV, XXXV and XXXIII are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together, and Invention XXXIII has different functions, being drawn to a method of treating keratinous fibers.

Inventions I, XI, XVIII, XXXV and XXXIV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together, and Invention XXXIV has different functions, being drawn to a method of making the composition.

Inventions I, XI, XVIII, and XXXV are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different

Art Unit: 1616

modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not disclosed as capable of use together, and Invention XXXV has different functions, being drawn to a composition containing at least three-hydrocarbon based repeating units.

3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Because these inventions are distinct for the reasons given above and the search required for Groups I-XXXV is not required for Group XXXV-I, restriction for examination purposes as indicated is proper.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

4. Claim 1, 108, and 213 are generic to a plurality of disclosed patentably distinct species comprising one structuring polymer, one hydrocarbon-based repeating unit, one hetero atom, one oil-soluble surfactant. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species **for each of** one structuring polymer, one hydrocarbon-based repeating unit, one hetero atom, **and** one oil-soluble surfactant, even though this

Art Unit: 1616

requirement is traversed. Failure to elect a species for each of the above listed will result in the Response to Office Action being NON-RESPONSIVE.

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

5. A telephone call was made to Thalia Warnement on 3/20/02 to request an oral election to the above restriction requirement, but did not result in an election being made.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robert M DeWitty whose telephone number is 703-308-2411. The examiner can normally be reached on 9:00am - 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees can be reached on 703-308-4527. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-7924 for regular communications and 703-308-7924 for After Final communications.

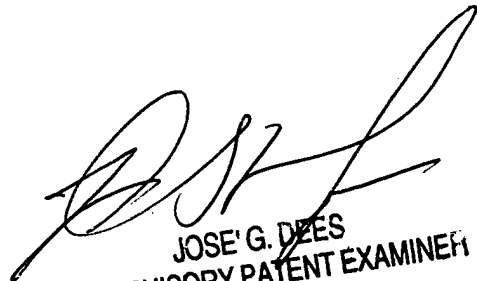
Application/Control Number: 09/733,900

Page 17

Art Unit: 1616

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1235.

RMD
March 24, 2002


JOSE G. DEES
SUPERVISORY PATENT EXAMINER
1616